



41  
Attorney Docket No.:  
MORN-0006 (108347.00017)

1616  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kemp, et al.

Serial No.: 09/655,131

Filed: 09/05/00

For: **HIGHLY ACIDIC METALATED ORGANIC ACID**

Group No.: 1616

Examiner: John D. Pak

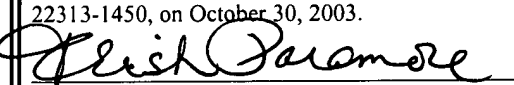
RECEIVED

NOV 06 2003

TECH CENTER 1600/2900

Mail Stop Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

<p style="text-align: center;">CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box: 1450, Alexandria, VA 22313-1450, on October 30, 2003.</p> <p> Trish Paramore</p> <p>(Signature of the person signing the certificate)</p>
--

RESPONSE

Responsive to the Office Action dated August 8, 2003, having a shortened statutory period for responding expiring November 8, 2003, Applicants respectfully request reconsideration in view of the following remarks.

I. Pending Claims

The Examiner has stated that claims 1, 3, and 10-11 are pending in this application in light of Applicant's election of species. Applicant respectfully submits that claim 6 reads on the elected subject matter as well. Claim 6 is directed to the acidic composition of Claim 1, "wherein the polyvalent cation comprises **an ion of magnesium**, calcium, ferrous, copper, or

zinc.” Applicant’s elected species includes an ion of magnesium. For this reason, Claim 6 is directed to elected subject matter and should therefore be pending in the application as well.

## II. Double Patenting Rejection

Claims 1, 3, and 10 – 11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,572,908. Applicants respectfully submit that the current application was filed on **September 5, 2000**, while U.S. Patent No. 6,572,908 was filed four months later, on **January 19, 2001**. Thus, any patents issuing from the current application will necessarily expire prior to U.S. Patent No. 6,572,908 due to an earlier filing date. For this reason, there is no risk of an “unjustified or improper timewise extension of the ‘right to exclude’ granted by a patent” and there should not be a double patenting issue. Applicants respectfully request that this rejection be withdrawn.

## III. Rejections Under 35 U.S.C. §103(a)

Claims 1, 3, and 10 – 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 00/48469. Claim 1 was previously amended to recite the use of an **organic acid generated from a salt of the organic acid**.

The Examiner asserts that there is not a patentable distinction between an organic acid and an organic acid generated from its salt because the claims require only an organic acid. Applicants respectfully submit that the organic acid generated from its salt is an organic acid species that differs from directly added organic acid and which produces different physical characteristics within the acidic composition.

The pending claims define the acidic composition in terms of the species or entities which are present after mixing at least one regenerating acid and at least one metal salt of an organic acid. *See*, Specification, Page 8, lines 12 – 24. These species include (1) a monovalent or polyvalent cation, (2) an organic acid generated from a salt of the organic acid, and (3) an anion of a strong oxyacid. *See*, Claim 1. It is **expected** that the regenerating acid will regenerate

the organic acid from its salt. *See*, Specification, Page 9, lines 23 – 25. However, **the acidic composition is also more biocidal than a mixture of the organic acid and a metal salt of the organic acid having the same normality.** *See*, Specification, Page 7, lines 13 – 16; Page 8, lines 8 – 11; and Claim 1. Thus, **Applicants respectfully submit that the organic acid species generated from a salt of the organic acid possesses different physical characteristics compared to the organic acid added directly to the acidic solution.**

Although it is expected that the organic acid is regenerated, the exact nature of the organic acid species is unknown. However, the regenerated organic acid produces beneficial effects by increasing the biocidal activity of the composition and therefore is distinguishable from an organic acid added directly.

Applicants respectfully submit that these different physical characteristics and beneficial effects could not have been predicted based on the knowledge of the effects of the AGIIS solution and the organic acid separately. WO 00/48469 teaches the optional addition of an organic acid directly to an acidic solution. WO 00/48469 does not teach or suggest an acidic composition having an organic acid species generated from its salt which produces increased biocidal characteristics. **Because the acidic composition has unique and unexpected physical properties, it is patentable over WO 00/48469.**

#### IV. Conclusion

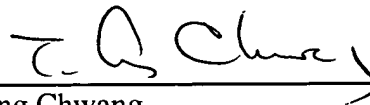
Applicants respectfully submit that, in light of the foregoing Amendments and comments, Claims 1, 3, 6, and 10-11 are in condition for allowance. A Notice of Allowance is therefore requested.

Attorney Docket No.:  
MORN-0006 (108347.00017)

PATENT

If the Examiner has any other matters which pertain to this Application, the Examiner is encouraged to contact the undersigned to resolve these matters by Examiner's Amendment where possible.

Respectfully submitted,



---

T. Ling Chwang  
Registration No. 33,590  
JACKSON WALKER L.L.P.  
2435 North Central Expressway, #600  
Richardson, TX 75080  
Tel: (972) 744-2919  
Fax: (972) 744-2909

---

October 30, 2003

Date